



AF-  
JFW

PTO/SB/21 (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/741,207
	Filing Date	December 19, 2000
	First Named Inventor	Timothy P. Barber
	Art Unit	3624
	Examiner Name	Daniel S. Felten
Total Number of Pages in This Submission	Attorney Docket Number	2-604.6-1

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<b>Remarks</b> REPLY TO EXAMINER'S ANSWER MAILED ON JAN. 9, 2007 (sent in triplicate)	

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Ware, Fressola, Van Der Sluys & Adolphson LLP		
Signature			
Printed name	James A. Retter		
Date	January 19, 2007	Reg. No.	41,266

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature			
Typed or printed name	Sue Muro	Date	January 19, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Att. Docket 2-604.6-1  
Ser. No. 09/741,207

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

First named inventor: Barber, Timothy P.

Serial No.: 09/741,207

Filed: Dec. 19, 2000

Title: Method for Secure, Closed Loop Money Transfer via  
Electronic Mail

Group Art Unit: 3624

Examiner: Felten, Daniel S.

MAIL STOP APPEAL BRIEFS--PATENTS  
COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

**REPLY TO EXAMINER'S ANSWER**

Sir:

This paper is in reply to the Examiner's Answer mailed on  
Jan. 9, 2007.

**CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))**

I hereby certify that this correspondence is, on the date shown below, being:

☒ **MAILING**  
Deposited with the United States Postal  
Service with sufficient postage as first class  
Mail in an envelope addressed to the  
Commissioner for Patents, PO Box 1450,  
Alexandria, VA 22313-1450.

☐ **FACSIMILE**  
Transmitted by facsimile to the U.S. Patent and  
Trademark Office.

Date: Jan. 19, 2007

Sue Muro

Signature  
Sue Muro/ Annmarie Maher  
(type or print name of person certifying)

REMARKS

In the Appeal pending in this matter, applicant hereby acknowledges receipt of the Examiner's Answer mailed 9 Jan. 2007. Applicant notes that the Examiner's Answer does not contain a rejection designated as a new ground of rejection, although the rejection of claim 1 is now indicated as under 35 USC 103(a) as being unpatentable over Kuzma (US 5,771,289) in view of Kuzma (US 5,771,289) in view of Messner (US 6,370,514)" but applicant believes that this is typographical error, and anyway, it is not designated as a new ground of rejection. Therefore a reply brief is not required to maintain the appeal, and applicant hereby requests that the appeal be maintained. In addition, though, applicant responds to the Examiner's Answer as follows:

In "Response to Argument" at page 7 of the Examiner's Answer, the Examiner seems to concede that the Office "focuses too much on the use of the word 'stamp' ... in the claims." (A stamp, as recited, is affixed to an email and redeemable for a value indicated thereon, and thus serves as a reward to the recipient for having gone to the trouble to redeem it, and probably having read the email.) Applicant has suggested that a fair reading of the claims would interpret the term "stamp" as "reward indicia." It seems from the Answer that the Examiner is agreeable to this interpretation. Applicant nonetheless, just to be certain that the Office construes "stamp" when recited in the claims to mean reward indicia instead of its more usual meaning, refers the Office to *Phillips vs. AWH Corp.*, 415 F.3d 1303, 75 USPQ.2d 1321 (Fed. Cir. 2005), an *en banc* decision, where the court explained again that:

[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term. ... That [the specification] starting point [for understanding a

claim term] is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art. ... Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.

The word "stamp" as used in the claims is thus fairly construed as used in the specification and as impliedly defined in the claims themselves, which is different than its normal meaning (indicating an amount paid for delivery of a message). A "stamp" as recited in the claims must be construed as indicating a reward for having redeemed it. A "stamp" as recited in the claims thus differs fundamentally from the "stamp" disclosed in Kuzma, which is explained to be a packet of data instructing an electronic post office (250) that an electronic message (202) should be transmitted, possibly including a unique code for authenticating the stamp, and possibly a graphic indicating cancellation, but of course nowhere indicating a value available to someone who might "redeem" the stamp as in the invention. To distinguish here from the stamp recited in claim 1 and the stamp disclosed in Kuzma, the latter will be referred to here as a Kuzma stamp.

The Examiner next asserts that appellant's brief argues the references individually, and points out that this cannot be done when, as here, the rejections are based on combinations of references. Applicant respectfully submits that appellant's brief argues specific assertions made by the Office, not references. Some of these assertions are that Kuzma by itself teaches some limitations recited in the claims, and some assertions are that Kuzma in combination with Messner, i.e. as modified by the teachings of Messner, teaches others of these limitations. In respect to the combination, appellant's brief also argues that there is no motivation to alter the teachings of

Kuzma according to the teachings of Messner as in the Office action, i.e. to replace the electronic stamp of Kuzma with the voucher of Messner.

To summarize, appellant's brief disputes the following assertions by the Examiner in the Office action mailed June 16, 2005 (and repeated in the Examiner's answer):

that Kuzma discloses a method of providing for a money transfer over a network (the brief arguing that Kuzma discloses instead affixing to an email an electronic analog of an ordinary postage stamp, i.e. a Kuzma stamp, which is only proof of money having been spent, not a transfer of money);

that Kuzma discloses a step of providing a stamp (as in the invention) having a face value indicated on the stamp (the brief arguing that Kuzma nowhere discloses a "stamp" as that term is used in the claims, and any "value" that might be indicated by a Kuzma stamp--and it is not clear that any value is indicated--is not a value indicating an amount of money for which the stamp can be redeemed, as required by claim 1, but would be merely the amount of postage paid for);

that Kuzma discloses a stamp being a string that is a concatenation of two or more fields including the face value (the brief arguing that Kuzma nowhere discloses the use of concatenation in forming a Kuzma stamp, and even if concatenation were used, since Kuzma does not disclose a face value as that term is used and defined in the claims, Kuzma cannot be said to disclose a concatenation of fields including the face value);

that there is motivation to change the teachings of Kuzma according to the teachings of Messner by replacing the Kuzma stamp with a Messner voucher, and further, that it would have been obvious to change the Messner voucher by indicating a lifespan on its face (the brief arguing that there would be no more motivation to so change the teachings of Kuzma than there

would be to change the ordinary mail system in the same way, using vouchers instead of postage stamps, even though vouchers, i.e. gift certificates or coupons, have been around a long time); and

that the combination of Kuzma and Messner, with the further change to show a lifespan, teaches allowing the recipient of an e-mail having a stamp (which would be the voucher of Messner, with the combination made in the Office action) obtain value for the stamp if the stamp is presented to a predetermined entity within the lifespan indicated on the stamp (the brief arguing that since Messner teaches that the voucher is paid for before it is affixed to an email, it is not likely that there would be any time limit as indeed there is no such teaching in Messner, and so the combination of what is actually disclosed by Kuzma and Messner does not teach or suggest redeeming but only if within a lifespan indicated on the stamp).

In regard to this last point, in preparing this paper applicant's attorney discovered that at col. 12, line 23, Messner discloses "a specified time frame" during which a voucher is valid, and, in case of a gift certificate, if not redeemed within the time period, the gift certificate expires and either the amount paid by the purchaser is not refunded, or it is returned, depending on whether "insurance" is also purchased by the purchaser of the gift certificate. Thus, applicant withdraws the assertion that it is not likely that there would be any time limit in case of a Messner voucher.

However, applicant now argues still further that the combination made by the Examiner is improper (besides arguing that there is no more motivation to change Kuzma per Messner than there is to change our "snail mail" system to use gift certificates in place of stamps). The MPEP at 2143.01 (V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY

FOR ITS INTENDED PURPOSE), cites *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), for the rule that, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Applicant respectfully submits that the use of Messner's vouchers in place of Kuzma's stamps would frustrate the intended purpose(s) of Kuzma, and so the combination is improper.

Kuzma explains at col. 1, line 60, that "It ... is desirable to provide a system for prepaid electronic message transmission where payments are directly proportional to use." Kuzma explains that often an electronic communication channel over which email is sent is paid for regardless of its use, and it would be perhaps beneficial to (pre-)pay as you go for email. Kuzma sets out objects, i.e. intended purposes, at col. 2, beginning line 27:

It is an object of the invention to provide a method and apparatus for paying for transmission of electronic data substantially concurrently with the transmission.

It is a further object of the invention to provide a method and apparatus for acquiring electronic stamps usable as payment for the transmission of an electronic message.

It is a further object of the invention to attach the electronic stamps to an electronic message thereby providing payment for the transmission of the message.

Another object of the invention is to mark the electronic stamps after they have been used to identify them as having been used to pay for the transmission of an electronic message. [Emphasis added.]

Kuzma also explains at col. 8, line 65, that another intended purpose of the stamps of Kuzma is to "regulate" the use of e-mail so as not to overburden the email system. Thus, Kuzma can fairly be said to also have as an intended purpose the prevention of spam.

Now the combination made by the Examiner changes the teaching of Kuzma by replacing the stamp of Kuzma with the

voucher of Messner. The voucher of Messner is said to be either a gift certificate, entitling the recipient to obtain goods or services up to the amount paid, or a coupon, entitling the recipient to a discount (percentage or dollar amount) in the purchase of goods or services. Applicant respectfully points out that when the purchaser of a voucher pays for the voucher, the purchaser is not paying for the transmission of an electronic message, but is instead paying for goods and services entirely unrelated to the transmission of an electronic message. (Even the amount of a voucher belies any assertion it is useable as payment for transmission of an electronic message. The cost of an electronic message could not reasonably be more than the cost of ordinary first-class postage, since the cost of delivery is so much less. In contrast, a voucher is for a significant amount of money, enough for the recipient to acquire goods or services the recipient would like to acquire.) Thus, replacing the Kuzma stamp with a Messner voucher frustrates all of Kuzma's objects related to paying for transmission of an electronic message, since that is not what a Messner voucher does. Further, Messner vouchers are not "marked" in any way to show they have been used, and so Kuzma's object of marking stamps to identify them as having been used to pay for a transmission is also frustrated.

Moreover, replacing a Kuzma stamp with a Messner voucher will not regulate email, i.e. it will not stop spam. A spammer would not have to use a voucher, i.e. a voucher is optional (and would have to be, for the reasons given above regarding the cost of a voucher compared to the cost of a stamp), but a stamp would be required. In the alternative, if it is asserted by the Office that a voucher would be required, the amount paid for the voucher would be at the discretion of the purchaser, and so could be *de minimis*, and thus there would be a correspondingly small effect on stopping the spammer.



Applicant therefore respectfully submits that one of ordinary skill in the art would never have modified the teachings of Kuzma in view of the teachings of Messner, i.e. it would not have been obvious to make the combination made by the Examiner.

For all of the aforementioned reasons and also for the reasons given in the appeal brief, it is respectfully insisted that the rejection of claim 1, and hence of all the claims in the application, namely claims 1-8, are error, and the rejections should be reversed. Early allowance of all the claims in the application is earnestly solicited.

19 Jan. 2007 \_\_\_\_\_

Date

WARE, FRESSOLA, VAN DER SLUYS  
& ADOLPHSON LLP  
755 Main Street, P.O. Box 224  
Monroe, CT 06468-0224

Respectfully submitted,



James A. Retter  
Registration No. 41,266

tel: (203) 261-1234  
Cust. No.: 004955